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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/814,328
Filing Date: March 31, 2004
Appellant(s): MONSEN ET AL.

Ronald Reichman
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 08 2008 appealing from the Office action mailed August 20 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2003/0101147	Montgomery et al	5-2003
5,174,398	Ng	12-1992

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 5-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pub No. 2003/0101147 to Montgomery et al.

Referring to claim 1:

a method for providing proof of mailing one or more mail pieces by a mailer, the method comprises the steps of:

- (a) placing an identification code on individual mail pieces with a postage meter at a location other than a post office, wherein the identification code identifies the recipient of the mail piece and uniquely identifies individual mail pieces; [0112]
- (b) transmitting the identification code to a data center; [0108]-[0110], [0184]
- (c) depositing one or more mail pieces with the post office at the post office or at a location other than the post office; [0184]
- (d) attempting reading by the post office at a location other than the post office or at the post office the identification code that is on one or more mail pieces; [0184], (Fig 31)

Montgomery et al does disclose a tracking information database 456 for storing each tracking ID that has been issued to an end user computer 308 and the postage

information associated with each tracking ID ... and periodically retrieving postage information from the tracking information database 456 for transmission to the master tracking computer system 310. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Montgomery et al to retrieve the identification code from the data center and the identification code read by the post office since the delivery status are updated after the mail pieces is read by the postal authority, and it would be necessary for the postal authority to retrieve the identification code in order to update the delivery status.

and

(f) notifying the postage meter that individual identification codes have been received by the data center and individual mail pieces identification codes have been read or not read by the post office. [0184], (Fig 31)

Montgomery et al does not expressly disclose printing at the postage meter a certificate indicating that the identification code has been read by the post office. However, Montgomery does disclose that the status of the mailpiece is update by the central computer, and the status can be checked on a webpage (Fig 27). Therefore, at the minimum the status webpage can be printed to indicate that the identification code has been read by the post office. It would have been obvious at the time of the invention for Montgomery et al to substitute printing the webpage at anywhere a printer is available with printing the webpage at the postage meter. Since printing a webpage and printing at a postage meter are well known in the arts, the simple substitution of one known element for another producing a predictable result renders the claim obvious.

Referring to claim 2:

the method claimed in claim 1, wherein the postage meter is an electronic postage meter. [0104]

Referring to claim 3:

the method claimed in claim 1, wherein the postage meter is a computer postage meter with a secure storage device. [0104], [0127]

Referring to claims 5 and 6:

Montgomery et al disclose storing a date and time of when the mailpiece was read. Montgomery et al does not expressly disclose printing on the certificate the date and time the mail pieces was read. However, it is well known in the arts for the status of the mailpiece to be printed for evidence purposes, therefore it would have been obvious for Montgomery et al to also print the date and the time of when the mailpiece was read for evidence purposes.

Referring to claim 7:

the method claimed in claim 1, further including the step of:
printing at the postage meter a certificate indication that the identification code has not been read by the post office after a certain period of time has elapsed after the data center has received the identification code from the meter. [0186]

Referring to claim 8:

the method claimed in claim 1, wherein the identification code is a unique number. [0078]

Referring to claim 9:

the method claimed in claim 1, wherein the identification code comprises: the serial number of the postage meter, and the date and time that the identification code was affixed to the mail piece. (Table 2)

Referring to claim 10:

the method claimed in claim 1, further including the steps of:

- (a) printing a postal indicia on the mail piece for the payment of postage and any related postal fees; (Fig 2) and
- (b) charging the postage meter for printing the postal indicia. [0187]

Referring to claim 11:

the method claimed in claim 10, further including the step of:
refunding the postage meter account for part or all of the postage and fees that have been places on mail pieces having identification codes that have not been read by the post office after a certain period of time has elapsed after the data center has received the identification code from the meter. [0187]-[0189]

Referring to claims 12-14:

Montgomery et al does not expressly disclose notifying the mailer via telephone, e-mail, or facsimile that individual identification codes have been received by the data center and individual mail piece's identification codes have been read or not read by the post office. However, Montgomery et al does disclose that the mailpiece status can be checked on a website (Fig 27). Telephony, e-mail and facsimile are well known notification methods in the arts. Therefore, it would have been obvious at the time of

the invention for one ordinary skilled in the arts to substitute the website with telephone, e-mail or facsimile to notify the mailer of the mailpiece status.

Referring to claim 15:

the method claimed in the claim 1, further including the steps of:
identifying the mailer's reference number of the document contained in the mail piece. (Table 3)

Referring to claim 16:

the method claimed in claim 15, further including:
(a) printing at the postage meter a certificate indicating that the identification code has not been read by the post office after a certain period of time has elapsed after the data center has received the identification code from the meter; (Table 3)

and

Montgomery et al does not expressly disclose the step (b) printing the mailer's reference number on the certificate of induction. However, since the reference number is known, it would have been obvious to print the reference number on the certificate of induction.

Referring to claim 17:

Montgomery et al does not expressly disclose printing the mailer's name on the certificate of induction. However, it would have been obvious for Montgomery et al to print the mailer's name on the certificate of induction to facilitate the identification process.

Referring to claim 18:

Montgomery et al disclose that the mailpiece status can be tracked and checked. (Fig 27) Montgomery et al does not expressly disclose printing at the postage meter a certificate indicating that the identification code has been read by the post office and printing the mailer's reference number on the certificate of induction. However, it would have been obvious at the time of the invention for Montgomery et al to print the status of the mailpiece along with the mailer's reference number. Montgomery et al would have been motivated to do so to provide the mailer with a record of the mailpiece status.

Referring to claim 19:

Montgomery et al does not expressly disclose printing the mailer's name on the certificate of induction. However, it is well known in the arts at the time of the invention for the mailer's name to be printed on the certificate of induction for identification and evidence purposes. Therefore it would have been obvious at the time of the invention for Montgomery et al to also print the mailer's name on the certificate of induction for identification and evidence purposes.

Referring to claim 20:

Montgomery et al disclose wherein the mailer selected a service level for the mail piece to be certified mail. [0080]

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery et al in view of U.S. Pat No. 5,174,398 to Ng.

Montgomery et al disclose a plurality of type of service levels that a user can select for a mail piece. [0080] Montgomery et al does not expressly disclose that registered mail is a service level that can be selected.

Ng discloses many mail service levels can be selected, such as registered mail.
(col 1: lines 15-18)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Montgomery et al to include registered mail as a service level that a user can select for a mail piece since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one ordinary skill in the art would have recognized that the results of the combination were predictable.

(10) Response to Argument

The applicant argues that Montgomery does not disclose or anticipate steps (e) and (g) of claim 1, specifically (e) retrieving the identification code from the data center and the identification code read by the post office and (g) printing at the postage meter a certificate indicating that the identification code has been read by the post office to provide proof of mailing the mail piece having the identification code. The Examiner respectfully disagrees.

As presented in the previous office action, Montgomery et al does not expressly disclose the step: (e) retrieving the identification code from the data center and the identification code read by the post office; Montgomery et al does disclose a tracking information database 456 for storing each tracking ID that has been issued to an end

user computer 308 and the postage information associated with each tracking ID ... and periodically retrieving postage information from the tracking information database 456 for transmission to the master tracking computer system 310. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Montgomery et al to retrieve the identification code from the data center and the identification code read by the post office since the delivery status are updated after the mail pieces is read by the postal authority, and it would be necessary for the postal authority to retrieve the identification code in order to update the delivery status.

With regards to step (g), as presented in the previous office action, Montgomery et al does not expressly disclose printing at the postage meter a certificate indicating that the identification code has been read by the post office. However, Montgomery does disclose that the status of the mailpiece is update by the central computer, and the status can be checked on a webpage (Fig 27). Therefore, at the minimum the status webpage can be printed to indicate that the identification code has been read by the post office. It would have been obvious at the time of the invention for Montgomery et al to substitute printing the webpage at anywhere a printer is available with printing the webpage at the postage meter. Since printing a webpage and printing at a postage meter are well known in the arts, the simple substitution of one known element for another producing a predictable result renders the claim obvious.

Regarding claim 21, the claim is rejected under 35 U.S.C. §103(a) over Montgomery in view of Ng. The Applicant asserts that “Montgomery and/or Ng taken separating *[sic]* or together do not disclose or anticipate obtaining from a postage meter

a certificate indicating the mailer selected a service level for the mail piece to be registered mail that has been read by the Post Office.” The Examiner must note that as disclosed in the Final Office Action, Montgomery et al disclose a plurality of type of service levels that a user can select for a mail piece. [0080] However, Montgomery et al does not expressly disclose that registered mail is a service level that can be selected. The Ng reference was brought in to show that selecting a mail service level, such as registered mail, is well known in the arts and have been in use for an extended period of time before the filing date of the Applicant's application. Furthermore, claim 21 only recites wherein the mailer selected a service level for the mail piece to be registered mail. Even taken together with the limitations of independent claim 1, the printout certificate only has to indicate that the identification code has been read by the post office and not the mailer selected a service level for the mail piece to be registered mail that has been read by the Post Office as asserted by the Applicant. The Applicant must be reminded that the features upon which applicant relies (i.e., certificate indicating the service level of mail) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Rutao Wu

/R. W./

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